

**REMARKS**

Applicants submit this Amendment in reply to the Office Action dated March 3, 2003.

In this Amendment, Applicants have cancelled claims 2-3, 7, and 18-20, without prejudice or disclaimer, and amended claims 1, 4-6, and 8-13 to more clearly define the claimed invention. Claims 1 and 14 sole independent claims.

Before entry of this Amendment, claims 1-20 were pending in this application. After entry of this Amendment, claims 1, 4-6, and 8-17 are pending in this application.

The originally-filed specification, claims, abstract, and drawings fully support the subject matter of amended claims 1, 4-6, and 8-13. No new matter was introduced.

In the Office Action, the Examiner rejected claims 7 and 8 under 35 U.S.C. §112, second paragraph, for indefiniteness; rejected claims 1 and 11 under 35 U.S.C. §102(e) as being anticipated by Daecher et al. (U.S. Patent No. 6,183,829 B1) ("Daecher"); rejected claims 1-4, 6-14, 16 and 17 under 35 U.S.C. §103(a) as being unpatentable over Shuto et al. (U.S. Patent No. 6,139,785) ("Shuto") in view of Daecher; rejected claim 5 as being unpatentable over Shuto in view of Daecher and further in view of Schulz (U.S. Patent No. 4,820,813); and rejected claims 15 and 18-20 as being unpatentable over Shuto in view of Daecher and further in view of Aizawa et al. (U.S. Patent No. 4,427,741) ("Aizawa") and Conrad et al. (U.S. Patent No. 4,726,659) ("Conrad").

Applicants have amended claims 7 and 8 to more clearly define the claimed invention. Accordingly, Applicants respectfully request the withdrawal of the §112, second paragraph rejection.

Applicants respectfully traverse the §102(e) rejection. For anticipation under 35 U.S.C. §102, the reference must teach every aspect of the claimed invention either explicitly or implicitly. M.P.E.P. 706.02. Because Daecher does not teach every aspect of claims 1 and 11 either alone or in combination with the other aspects of the claimed invention, Daecher does not anticipate any of those claims.

Daecher does not disclose or suggest the invention claimed in independent claim 1. For example, independent claim 1 recites a polarizing plate protective film including, among other aspects, wherein "a length of the polarizing plate protective film is at least 1000 m," wherein "a thickness of the polarizing plate protective film is 20 to 60  $\mu\text{m}$ ," and wherein "variation in the thickness of the polarizing plate protective film is within  $\pm 3.0$  percent to an average thickness of the polarizing plate protective film." Daecher does not disclose at least these aspects of the invention either alone or in combination with the other aspects of the claimed invention.

Specifically, Daecher discloses a process and apparatus for forming a plastic sheet, but does not disclose a polarizing plate protective film as recited in claim 1. Furthermore, the only dimensions for the film that Daecher discloses is a 400x400 mm piece cut from the cooled sheet, and not "at least 1000 m" as recited in claim 1. Additionally, as asserted by the Examiner on page 3 of the Office Action, Daecher does disclose a film having an average thickness of 54  $\mu\text{m}$  with variation of 4  $\mu\text{m}$ . (Col. 17, lines 23-26). However, a variation of 4  $\mu\text{m}$  for a thickness of 54  $\mu\text{m}$  is  $\pm 7.4\%$ , and not  $\pm 3.0$  percent as recited in claim 1. While, the Examiner may assert that the  $\pm 7.4\%$  recited in Daecher encompasses the claimed range of  $\pm 3.0$  percent and thus anticipates it, "[i]f the claims are directed to a narrow range, the reference teaches a broad range,

and there is evidence of unexpected results within the claimed narrow range... it may be reasonable to conclude that the narrow range is not disclosed with 'sufficient specificity' to constitute an anticipation of the claims." M.P.E.P. § 2131.03. This section of the M.P.E.P. is applicable here as Applicants have set forth, on pages 5-7 of the specification, the importance of the claimed range of  $\pm 3.0$  percent.

Further, as the results of the detailed investigation on the ratio of wrinkle formation as well as variation in film thickness, it has been discovered that at the film thickness of no more than 60  $\mu\text{m}$ , when variation in film thickness is within  $\pm 3.0$  percent of the standard thickness (average film thickness) of said film is preferably  $\pm 2.9$  percent, and is more preferably  $\pm 2.8$  percent, wrinkles, which are not permitted as the polarizing plate protective film, are not formed. (Page 5 of the specification).

When the variation in the film thickness is controlled within  $\pm 3.0$  percent of the standard film thickness, in the case of a thin film in the range of 20 to 60  $\mu\text{m}$ , especially in the range of 25 to 55  $\mu\text{m}$ , and further in the range of 30 to 55  $\mu\text{m}$ , wrinkles are not substantially formed. Namely, wrinkles which are not permitted in the film for a liquid crystal display unit, especially a polarizing plate protective film, are not substantially formed. For example, when a 5000 m long film is wound, wrinkles, which are not permitted in the polarizing plate protective film, are not formed. As a result, the production yield increases. (Pages 6-7 of the specification).

Accordingly, because Daecher does not disclose every aspect of the invention either alone or in combination with the other aspects of the claimed invention, Applicants respectfully request withdrawal of the §102(e) rejection.

With regard to the § 103(a) rejections, Applicants initially note that "the examiner bears the initial burden, on review of the prior art on any other ground, of presenting a *prima facie* case of unpatentability." In re Oetiker, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (emphasis original). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art references, when combined, must teach or suggest all of the claim limitations. Second, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Finally, there must be a reasonable expectation of success. M.P.E.P. §2143.

Applicants respectfully disagree with the Examiner's arguments and conclusions, and submit that a *prima facie* case of obviousness has not been established. No proper combination of the cited references, including Daecher, Shuto, Aizawa, Conrad, and the other art of record, teaches or suggests the present invention as claimed in independent claim 1 and 14.

For example, as set forth above with respect to the §102(e), Daecher does not disclose or suggest every aspect of claim 1, and Applicants assert that neither Shuto, Aizawa, or Conrad remedy this deficiency. Indeed, the Examiner has not asserted otherwise in the Office Action. Moreover, neither Daecher, Shuto, Aizawa, nor Conrad disclose or suggest every aspect of claim 14. For example, none of the cited art disclose or suggest "a polarizing plate protective film wherein thickness of the polarizing plate protective film is 20 to 60  $\mu\text{m}$  and variation in the film thickness of the polarizing plate protective film is within  $\pm 3.0$  percent the standard film thickness" as set forth in claim 14.

As set forth above with respect to the §102(e) rejection, none of the cited art, including Daecher, teach or suggest that the "variation in the film thickness of the polarizing plate protective film is within  $\pm 3.0$  percent the standard film thickness." Accordingly, because the Examiner has not provided a proper case of *prima facie* obviousness for either independent claim 1 or independent claim 14, or their respective

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

dependent claims, Applicants respectfully request the withdrawal of the §103(a) rejection.

Applicants further submit that claims 4-6, 8-13, and 15-17 depend from one of independent claims 1 and 14, and are therefore allowable for at least the same reasons that each of those respective independent claims is allowable. In addition, at least some of the dependent claims recite unique combinations that are neither taught nor suggested by Daecher, Shuto, Aizawa, or Conrad, and therefore at least some also are separately patentable.

In view of the foregoing remarks, Applicants submit that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In discussing the specification, claims, abstract, and drawings in this Amendment, it is to be understood that Applicants are in no way intending to limit the scope of the claims to any exemplary embodiments described in the specification or abstract and/or shown in the drawings. Rather, Applicants are entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation, and applicable case law.

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
www.finnegan.com

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: September 2, 2003

By: 

Michael W. Kim  
Reg. No. 51,880

FINNEGAN  
HENDERSON  
FARABOW  
GARRETT &  
DUNNER LLP

1300 I Street, NW  
Washington, DC 20005  
202.408.4000  
Fax 202.408.4400  
[www.finnegan.com](http://www.finnegan.com)